

## REMARKS

### REQUIREMENT FOR INFORMATION

The Examiner requested information under 37 CFR 1.105. Applicants submit that they have submitted the relevant information in the specification as well as in PTO Forms 1449. Applicants are aware of their duty of disclosure and have and will continue to submit all the material information.

The information that could be properly requested by the Examiner is clearly itemized in 37 CFR 1.105. It would be improper to request additional information that is not supported by Rule 105. In particular, the Examiner made the following request for information (emphasis added):

"The Office is requiring submission of information reasonably necessary to properly examine and treat the claimed subject matter under Rule 105. Of particular interest is information used in drafting the present operation including information related to the field of endeavor or business practices used by **applicants' professional business ventures**, to show the information used in the invention process, and identification of any use of the claimed invention known to the inventor at the time the application was filed notwithstanding the date of the use. **Since the application is filed as a large entity status**, along with the fact that the assignee has other pending applications and/or patented inventions closely related to the claimed invention and an information disclosure statement has been filed without relating to those other more relevant pending applications and patented inventions, **it appears that it would be appropriate to require the applicants to provide information** necessary to ensure a quality examination may be performed by the Office."

Applicants object to the foregoing specific request made by the Examiner, on the ground that the request is vague and exceeds the scope of Rule 105. As an example, it is not clear what the Examiner means by "**applicants' professional business ventures**." Applicants are retained by the assignees and as

far as the present invention is concerned, they do not run professional business ventures.

In addition, the Examiner seems to have made the request for information because the application was filed **as a large entity status**. This too is an improper ground for making the request, in that the status of the application is irrelevant to the proper examination of the application. Does the Examiner imply that if the same application were filed as a small entity status he would not have made the request for information? Applicants reject such a differentiation that is not supported by statute.

Applicants respectfully submit that they will honor all specific requests for information that are properly made under the statute.

### **OBJECTION TO THE SPECIFICATION**

The Examiner objected to the specification requiring the deletion of hyperlinks and/or other form of browser-executable code under MPEP 608.01.

Applicants traverse this objection and respectfully submit that MPEP 608.01 was revised "to clarify that **examiners should not object** to hyperlinks where the hyperlinks and/or other forms of browser-executable codes are part of applicant's invention and are necessary to be included in the patent application to comply with the requirements of 35 U.S.C. 112, 1st paragraph, and applicant does not intend to have these hyperlinks be active links." As a result, Applicants respectfully submit that the hyperlinks objected to by the Examiner in the present application are not intended to be active links, and are

thus properly formatted. Applicants further submit that the objection is improper and that no amendment to the specification is necessary.

### **CLAIM REJECTION – 35 USC 101**

The Examiner rejected claims 22-26 under 35 USC 101. Applicants have now amended these claims in compliance with 35 USC 101.

### **CLAIM REJECTION – 35 USC 112, FIRST PARAGRAPH**

The Examiner rejected claims 1-26 under 35 USC 112, First Paragraph, reasoning that: "The independently claimed invention specifically reciting those steps is considered **non-enabling because the specification does not provide a concrete example** or illustrating of those claimed steps." Applicants respectfully submit that:

- (1) They have presented a concrete example at page 26 of the specification; and
- (2) further that the instant specification and drawings presented a concrete and complete explanation of the invention in compliance with 35 USC 112, First Paragraph.

The Examiner further based his rejection on the following ground: "The recited claim terms "desirability," "desirable," "inappropriate," or "disadvantageously" are subjective terms that are considered non enabling to those skilled in the art." Applicants submit that this objection does not constitute a proper rejection ground under 35 USC 112, First Paragraph.

Applicants further submit that:

- (1) The fact that the terms are subjective does not render the invention non-enabled. Applicants respectfully request that the Examiner provide the legal ground for the assertion he made to the contrary. Does the Examiner mean that any subjective term renders the claims objectionable under 35 USC 112, First Paragraph?
- (2) These terms have been used and described in the specification in a very objective context, and thus these terms should be interpreted in their proper context as opposed to their general meaning.

**CLAIM REJECTION – 35 USC 112, FIRST PARAGRAPH**

The Examiner rejected claims 1-26 under 35 USC 112, Second Paragraph. Applicants have amended some of the claims that were properly objected. Applicants further submit that other objections were not properly made and thus do not necessitate corresponding amendments to the claims. More specifically, the term "the following" does not require an antecedent basis.

**CLAIM REJECTION – 35 USC 102**

The Examiner rejected claims 1-26 under 35 USC 102 under numerous prior art references. Applicants submit that the examiner has not attached copies of the prior art references that are cited and/or relied upon to reject the claims. Applicants respectfully request copies of all the references with the exception of those references that are not cited on Applicants' Forms PTO-1449, according to MPEP Section 707.05(a) "Copies of Cited References."

The non-compliance with the foregoing MPEP requirements to submit copies of the references prevents the Applicants from preparing a viable and complete response to the Examiner's rejections. As a result, the office action is deficient, and Applicants request that such deficiency be corrected.

More specifically, the Examiner stated that:

"Claims 1-26 are further rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. An Office search of internet databases revealed that applicant's assignee, specifically International Business Machines Corporation, reveals that the claimed invention has been in public use since at least 1999 (based on financial disclosure statements announcing product developments during that year), which is more than one year from the priority filing date relied upon for the present application.

An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: other business ventures regarding the claimed invention in public use as known the applicants and the assignee. Applicants are reminded that failure to fully reply to this requirement for information will result in a holding of abandonment." Emphasis added.

Applicants respectfully submit that the Examiner has not explained the office search that revealed that the claimed invention has been in public use since at least 1999, nor has the Examiner referenced such search result on PTO form 892.

In addition, it is not clear what the Examiner means by "other business ventures" and which rule or statute the examiner bases his request for additional information for other business ventures (Rule 105 having been discussed earlier).

Moreover, the Examiner states that:

"Claims 1-26 are rejected under 35 U.S.C. 102(a) as being anticipated by applicants' specification to each of the independently claimed inventions. Since the specification background is customarily used as an introduction to admitted prior art while the claims introduce improvements to the admitted prior art, the independently claimed invention mirrors the specification in subject matter and functionality. In this case the claims contain the same subject matter as the specification background and since the background is normally admitted prior art, the claims and claims depending upon them are considered anticipated by the specification admitted prior art." Emphasis added

Applicants respectfully submit that the use of the background section as an anticipatory rejection ground, simply based on a customary use of the background to describe the problems facing the invention, is improper. The Examiner is respectfully requested to base the anticipation rejection on prior art references that are specified in 35 USC 102.

As a result, Applicants respectfully submit that the Examiner's rejection was not properly made and could not be responded to with specificity. Appropriate corrective action is requested.

### **CLAIM REJECTION – 35 USC 103**

The Examiner rejected claims 1-26 under 35 USC 103 as being unpatentable over an obvious variation of examiner's experience, without providing supporting evidence for the examiner's personal experience. As a result, Applicants are not able to respond with specificity to the Examiner's rejection. Applicants respectfully request that the Examiner substantiate his personal experience with tangible evidence. Absence such evidence, the Examiner has not met his burden of proof.

### **DOUBLE PATENTING REJECTION**

Claims 1 – 26 were rejected under the doctrine of double patenting based on numerous copending patent applications and patents. Applicants respectfully traverse this rejection and submit that a distinguishing feature of the present invention is the dynamic determination of the desirability of associating the advertisement with the web page, and the selective display of at least a portion of the advertisement if an association between the advertisement and the page is determined to be desirable.

As a result, Applicants submit that this feature is sufficiently distinguishing, thus overcoming the double patenting rejection.

### **CONCLUSION**

All the claims presently on file in the present application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned at the below-listed telephone number.

Respectfully submitted,



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